



TRANSMITTAL FORM

Application Serial Number	09/841,325
Filing Date	April 24, 2001
First Named Inventor	Modell
Group Art Unit	3737
Examiner Name	Smith, Ruth S.
Attorney Docket No.	MDS-009CN
Patent No.	Not applicable
Issue Date	Not applicable


ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Check Attached <input type="checkbox"/> Copy of Fee Transmittal Form <input type="checkbox"/> Amendment/Response <input type="checkbox"/> Preliminary <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Letter to Official Draftsperson including Drawings [Total Sheets ____] <input type="checkbox"/> Petition for Extension of Time <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Form PTO-1449 <input type="checkbox"/> Copies of IDS Citations <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Sequence Listing submission <input type="checkbox"/> Paper Copy/CD <input type="checkbox"/> Computer Readable Copy <input type="checkbox"/> Statement verifying identity of above	<input type="checkbox"/> Copy of Notice to File Missing Parts of Application <input type="checkbox"/> Formal Drawing(s) <input type="checkbox"/> Request For Continued Examination (RCE) Transmittal <input type="checkbox"/> Power of Attorney (Revocation of Prior Powers) <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Executed Declaration and Power of Attorney for Utility or Design Patent Application <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> CD(s) for large table or computer program <input type="checkbox"/> Amendment After Allowance <input type="checkbox"/> Request for Certificate of Correction <input type="checkbox"/> Certificate of Correction (in duplicate)	<input checked="" type="checkbox"/> Notice of Appeal to Board of Patent Appeals and Interferences <input type="checkbox"/> Appeal Brief (in triplicate) <input type="checkbox"/> Status Inquiry <input checked="" type="checkbox"/> Return Receipt Postcard <input type="checkbox"/> Certificate of First Class Mailing under 37 C.F.R. 1.8 <input type="checkbox"/> Certificate of Facsimile Transmission under 37 C.F.R. 1.8 <input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below) <ul style="list-style-type: none"> • Pre-Appeal Brief Request for Review • Comments on Pre-Appeal Brief Request for Review • Check in the amount of \$250.00
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Respectfully submitted,

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PTO/SB/36 (07-05)

**PRE-APPEAL BRIEF REQUEST
FOR REVIEW**

Application Number	09/841,325
Filing Date	April 24, 2001
First Named Inventor	Modell
Atty Docket Number	MDS-009CN
Art Unit	3737
Examiner	Smith, Ruth S.

CERTIFICATE OF MAILING OR TRANSMISSION

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Date

November 22, 2006

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34. _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



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PATENT

Attorney Docket No. MDS-009CN
(120407/156456)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Modell *et al.* CONFIRMATION NO.: 6590
SERIAL NO.: 09/841,325 GROUP NO.: 3737
FILING DATE: April 24, 2001 EXAMINER: Smith, Ruth S.
TITLE: METHOD AND APPARATUS FOR SCANNING A BIOLOGICAL
 SAMPLE
 [title as amended 3/20/06]

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COMMENTS ON PRE-APPEAL BRIEF REQUEST FOR REVIEW

This paper is submitted along with a Pre-Appeal Brief Request for Review in accordance with the Official Gazette Notice dated July 12, 2005, and a Notice of Appeal in response to the Office action mailed by the U.S. Patent and Trademark Office on August 24, 2006. A check for payment of the fee for filing the Notice of Appeal is submitted herewith. Applicants believe that no additional fee is required for this submission to be entered. However, please consider this a conditional petition for the proper extension, if one is required, and a conditional authorization to charge any related extension fee, or any other fees, necessary for entry of this submission to Deposit Account No. 07-1700.

Applicants' **Remarks** begin on page 2 of this paper.

REMARKS

The Examiner has improperly rejected all pending claims under 35 U.S.C. § 103(a). The Examiner fails to make *prima facie* rejections under 35 U.S.C. § 103(a). Specifically, a claim element that is clearly not present in applied art is not included in the Examiner's analysis.

Each of the pending independent claims 105 and 152 recites the limitation, "an internal biological sample, ... said sample not surgically exposed". The Examiner fails to show where this limitation allegedly appears in the cited art.

In the 8/24/06 Office Action, the Examiner alleges that U.S. Patent No. 6,424,852 (**Zavislan**) teaches, "The tissue can be internal biological tissue as disclosed in column 7, lines 34-47." However, the Examiner does not allege anywhere in the Office Action that **Zavislan** teaches or suggests an internal biological tissue not surgically exposed. Furthermore, all of the rejections cite a combination of references, all including **Zavislan**.

Zavislan describes a device for examination of the skin. **Zavislan** does not teach or suggest "an internal biological sample, ... said sample not surgically exposed". Even if one could argue the few lines of **Zavislan** dealing with "internal tissues" (col. 7, lines 45-47) enables one to use its skin examination device to examine a surgically-exposed cervix (such surgical exposure being necessary, as admitted at lines 45-47 of **Zavislan**, given the device described therein), this would still not teach or suggest scanning "regions of an internal biological sample ... said sample not surgically exposed," [emphasis added] as recited in each of independent claims 105 and 152.

Applicants further point to arguments already of record in Applicants' Amendment and Response of December 23, 2004, at page 9-10.

According to the MPEP, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP, Eighth Edition, Rev. Oct. 2005, § 2143. Applicants submit that there is clear error in the Examiner's rejections and that the Examiner fails to establish a *prima facie* case of obviousness by not showing how the cited art allegedly teaches or suggests the claim element, "an internal

biological sample, ... said sample not surgically exposed", which is common to both of the pending independent claims, claims 105 and 152.

Applicants respectfully assert that none of the cited art teaches or suggests the combination of elements recited in either claim 105 or claim 152, and that these claims are patentable in light of the cited art. Thus, all the dependent claims are patentable as well, at least for this reason, and a Notice of Allowance should be issued.

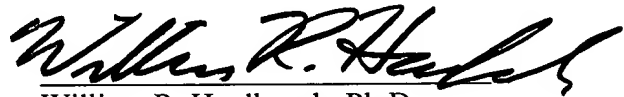
CONCLUSION

We respectfully submit that, as set forth in the foregoing remarks, there is clear error in the Examiner's rejections.

Respectfully submitted,

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